UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,103	12/28/2001	Dhananjay V. Keskar	042390.P11136	2363

7590 07/08/2005	EXAMINER
Crystal D Sayles Blakely Sokoloff Taylor & Zafman LLP 12400 Wishire Boulevard Seventh Floor Los Angeles, CA 90025	LE, BRIAN Q

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 April 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

  4a) Of the above claim(s) _5,14 and 21_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4,6-13,15-20 and 22-30_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____.
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5)☐ Notice of Informal Patent Application (PTO-152)
  Paper No(s)/Mail Date _____.   6)☐ Other: _____.

Response to Amendment and Arguments

1.   Applicant's amendment filed April 18, 2005, has been entered and made of record.

2.   The rejected claims 5-6, 14-15, and 21 under 35 U.S.C. 112, first paragraph regarding to

the support of the limitations "recognized only if the command mark is placed in a specified area

of the medium." and "first command mark must be recognized before any other command marks

are recognized as executable commands" is considered persuasive and thus withdrawn.

3.   For rejected claims 7 and 22 under 35 U.S.C. 112, first paragraph regarding to the

support of the limitations "the medium includes printed text, and wherein the recognized

command mark is executed to affect the printed text" is not consider persuasive and thus the

rejection is maintained. The Examiner read the cited location page 3, lines 8-11; page 3, line 22-

page 4, line 9 but still can not find the support for this claimed concept. The Applicant needs to

further indicate of how the cited location in the disclosure support this limitation.

4.   Applicant's arguments, see "Remarks", filed April 18, 2005, with respect to the

rejection(s)of claim(s) 1-3, 5-12, and 14-30 under 35 U.S.C. 102(b) have been fully considered

and are persuasive. Therefore, the rejection has been withdrawn. However, upon further

consideration, a new ground(s) of rejection is made in view of Lopresti et al. U.S. Patent No.

5,748,807.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

6.   Claims 7 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. Regarding to claims 7 and

22, the original disclosure does not show the support for the limitation "the medium includes

printed text, wherein when the recognized command mark is executed, the printed text is

affected". The Examiner read the cited location page 3, lines 8-11; page 3, line 22-page 4, line 9

but still can not find the support for this claimed concept. The Applicant needs to further

indicate of how the cited location in the disclosure support this limitation.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

8.   Claims 1-3, 5-12, 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by

Lopresti et al. U.S. Patent No. 5,748,807.

Regarding claim 1, Lopresti teaches a method comprising:

obtaining a scanned command mark written with a conventional writing implement onto

a conventional medium (abstract); and

recognizing the scanned command mark as a command that may be executed by a

processor, wherein the command mark is recognized only if the command mark is placed in a

specified area of the medium (FIG. 3, element 37 and column 6, lines 40-58).

Referring to claim 2, Lopresti teaches the method wherein the command mark comprises one of a operational mark (editing mark includes deletion and insertion marks) (column 10, lines 16-49).

For claim 3, Lopresti also teaches the method wherein recognizing comprises: recognizing a pattern associated with the command mark based on one of a statistical model (probability/computation system) (column 5, lines 35-40 and column 9, lines 35-44).

For claim 6, Lopresti discloses the method further comprising obtaining secondary command marks written on the conventional medium, wherein the command mark is recognized before the secondary command marks are recognized as executable commands (The process of recognizing marker commands before text recognition by sequence processing/iteration) (FIG. 9, elements 70 and 71; column 12, lines 38-50).

Referring to claim 7, Lopresti shows the method wherein the medium includes printed text, and wherein when the recognized command mark is executed, the printed text is affected (column 10, lines 16-56).

Regarding claim 8, Lopresti teaches the method further comprising: executing the recognized command in the processor (Edit command/deletion/insertion recognized/processed by computer) (10, lines 16-56).

For claim 9, Lopresti also teaches the method further comprising: storing the recognized command in memory (stores processed/recognized command in computer) (FIG. 2, Computer System).

Regarding claims 10-12, and 14-17, please refer back to claims 1-3 and 5-9 for the teachings and the explanations.

Regarding claim 18, please refer back to claim 1 for the teaching and explanation. In addition, Lopresti teaches a machine-readable medium that stores machine-executable instructions for perform the claimed limitations (the computer and software) (FIG. 2, Computer System and OCR Software).

Regarding claims 19-24, please refer back to claims 2-3, 5, and 7-9 for further teachings and explanations.

For claims 25-28, please refer back to claims 1-2, 18 and 9 for the teachings and explanations.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson U.S. Patent No. 5,897,648 as applied to claim 2 above, and further in view of Berman U.S. Patent No. 5,768,418.

Regarding claim 4, Henderson teaches the pattern recognition (recognized the edit command) (column 2, lines 56-67). Henderson does not explicitly teach the application of heuristic techniques to enhance accuracy of the pattern recognition. Berman further teaches a handwriting command processing utilizing the heuristic techniques (column 3, lines 30-36 and column 5, lines 40-45). Modifying Henderson's method of processing written command mark

according to Berman would able to utilize heuristic technique in pattern recognition to enhance

the accuracy. This would improve processing and therefore, it would have been obvious to one

of the ordinary skill in the art to modify Henderson according to Berman.

Regarding claim 13, please refer back to claim 4 for the teaching and explanation.

Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lopresti et al. U.S. Patent No. 5,748,807 and Henderson U.S. Patent No. 5,897,648.

Regarding claim 29, please refer back to claim 1 and 18 for the teachings and explanations.

Lopresti does not explicitly teach the method of obtaining stroke data and recognizing stroke

data. Henderson teaches a method of processing command marks (column 7, lines 15-26)

wherein the obtain stroke data that corresponds to the written command mark (digitizing and

scanning process) (column 2, lines 43-55), and recognize the stroke data as an executable

command (recognized the edit command and further provide the edited document) (column 2,

lines 56-67). Modifying Lopresti's method of processing command marks according to

Henderson would able to digitized edit format to editing document (column 2, lines 45-55). This

would improve processing and therefore, it would have been obvious to one of the ordinary skill

in the art to modify Lopresti according to Henderson.

For claim 30, Henderson further teaches the apparatus further comprising: a digital ink

detecting device which detects the command mark as stroke data (digitizer pen) (column 4, line
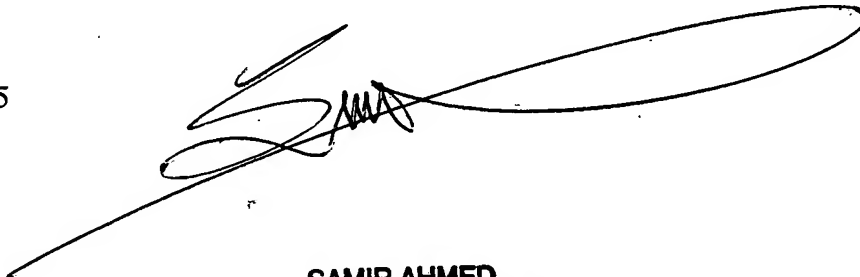
3-5).

Contact Information

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 571-272-7414. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

BL
June 30, 2005

**SAMIR AHMED
PRIMARY EXAMINER**